

### **Remarks**

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration on the merits thereof is respectfully requested.

There is but a single issue of record, namely, the rejection of all of the claims of record in the last Office Action "under 35 U.S.C. 103(a) as being unpatentable over French publication 2,720,145 [known hereafter as FR '145] in view of Peterson [U.S. Patent No. 3,857,624] and Kane et al. [U.S. Patent No. 5,540,493]."

The Supreme Court in the decision of Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) stated:

[8] While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp.*, supra, at 155, 87 USPQ at 307, the § 103 condition, which is one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under 103, the scope and content of the prior art are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy.

Turning first to the "scope and content" of the prior art, the undersigned has submitted herewith a translation of the FR '145 patent and has highlighted the portions of the specification which are considered significant to the issues of record, particularly with respect to independent claims 1 and 17 which are directed to the refrigerator compartment and the slidable shelf associated therewith, respectively. The FR '145 patent

describes "cornices which are separated and applied to the shelves by inserting the sides of the shelf in the corresponding cavity of the cornices characterized by the fact that the cavity have several interior protrusions made to engage the sides of the shelves." (See translation, second page, first four lines.) These cornices "clip on at the corresponding side of the shelf" and may be "shaped in 'L'." (See translation, page 2, second and third paragraphs.) Toward the bottom of the second page of the translation, Figures 1 and 2 are described as though the cornices 1, 1 above and below are of an identical construction. However, the same are not because only the two upper cornices is each "L-shaped" (translation, page 3, line 13). Therefore, the French patent discloses L-shaped cornices or border members, one at each of the two upper corners in Figures 1 and 2 and two relatively elongated cornices, one at each lower corner of the shelf of Figures 1 and 2. Each cornice is snap-secured to each corner to specifically avoid the use of "a continuous frame, which encloses the corresponding shelf," as described in the German patents on the first page of the FR '145 patent. Accordingly, it is fair to state that the scope and content of the FR '145 patent is that of providing a shelf with four cornices, two of which are L-shaped, two of which are elongated, and all of which are snap-secured to the shelf, specifically to the glass 8 along the fluting 7 thereof (Figures 5 and 6).

Amended claim 1 and amended claim 17 are of similar scope, one directed to the refrigerator compartment and the other directed to the slidable shelf, but in each case the shelf is recited as including the glass piece and front and rear border members, each of which is of a "single piece of substantially homogeneous polymeric/copolymeric molded synthetic material" and each being of a "substantially **U-shaped** configuration." Both

the border bight portion and the side border portions include glass edge-receiving channels into which the edges of the glass are received which results in the side border portions being directed in opposing relationship to each other and in relatively spaced relationship thereto to effect the desired air flow at sides of the shelf when within an associated refrigerator compartment.

The latter differences unobviously distinguish claims 1 and 17 over the French patent, because the latter discloses (1) two L-shaped cornices, (2) two elongated cornices and (3) no front and rear cornices of a U-shaped configuration with the side border portions or legs in opposing relationship to each other.

Turning to the secondary patents, the scope and content of the Peterson patent (3,857,624) is of no consequence since it deals with wire shelves which is of no consequence relative to air circulation through a refrigerator compartment within which are one or more glass shelves. The undersigned appreciates that the Peterson patent does disclose "opposing ledges (14, 16) and a refrigerator compartment allowing the shelf to be slid into and out of the compartment" and readily admits that such is "old" and well known. However, the undersigned will add to the latter that the shelf, once again, is a wire shelf(s), but if the sole purpose of the citation of Peterson is for the teaching of "ledges," it should be noted that there are lower ledges 14 and upper edges 16 which collectively **prevent** air circulation. Hence, this patent really has nothing to do with Applicant's appreciation of a problem and the solution thereof and has absolutely no pertinent teaching with respect to anything other than wire shelves, apart

from upper and lower ledges which **detract** from any suggestion or motivation relative to the invention herein claimed.

The remaining secondary patent is that to Kane et al. (5,540,493) which is assigned to the present assignee and discloses a single continuous one-piece shelf or frame which encapsulates a piece of glass. This is precisely the type of shelving which FR '145 seeks to improve because "the sides are covered by cornices made in plastic through injection molding." (See translation, page 1, mid portion thereof.) Though described as being aesthetic and protecting against sharp edges of the glass shelves, the French patent states: "that the molding step through injection is relatively expensive compared to the moderate value of the shelf; furthermore, in case of a break on one side of the shelf, it is necessary to replace the whole shelf." In other words, the Examiner has in Kane et al. the suggestion, motivation or teaching of a single continuous one-piece injection molded open frame encapsulating the entire periphery of a piece of glass, and the latter teaching, when considered in its entirety or *as a whole*, does not simply teach one skilled in the art "to utilize the bonded polymer material as taught by Kane et al." (See Office Action, page 4, mid portion thereof.) The Examiner's reference to "the bonded polymer material as taught by Kane" is certainly not an example of considering the prior art "in its entirety, i.e., *as a whole*." (See Panduit Corp. v. Dennison Manufacturing Co., 1 USPQ2d 1593, 1597.) As is further stated by the Panduit court: "No effective, uniform, reliable patent system could long survive if the law permitted as a decisional approach to § 103 determinations... (3) picking from a prior patent an item describable by that word (in effect finding *no* differences); (4) focusing on isolated minutiae in a prior art patent while disregarding its scope, i.e., its

entire disclosure, and how its disclosed structure works,” etc. With due respect, the combination of the prior art, as set forth in the rejection of the claims of record, is more than seriously faulted, is contrary to a proper application of the Graham, supra factors/conditions in arriving at a correct legal decision with respect to obviousness/unobviousness. In view of the foregoing, the formal allowance of similarly limited independent claims 1 and 17 and the claims depending therefrom is considered proper and would be most appreciated.

The undersigned has also added new independent claims 66 and 70 directed to a respective refrigerator compartment and slidable shelf, as illustrated in Figures 6 and 9 of the drawings, respectively. In Figure 6, the front and rear border members are of a relatively elongated construction terminating in terminal edges which lie substantially parallel to each other and in planes of the side edges of the glass, whereas in Figure 9 one of the border portions is shorter than the other to expose corners C1, C2 of the piece of glass. The prior art fails to suggest or render obvious either of these structures, again because the FR '145 patent is directed to four cornices or corner border members, two being L-shaped and two being elongated, but nowhere in the prior art is there found a shelf corresponding to the shelf of either Figure 6 or Figure 9. Accordingly, the formal allowance of the newly added independent claims, claims 66 and 70, as well as the claims depending therefrom is respectfully requested.

In view of the foregoing, the formal allowance of this application at an early date is herewith respectfully requested.

Respectfully submitted,

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Enclosures:      FR '145 patent translation w/highlighted portions